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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,201	04/13/2000	Michael Voticky	044839.0048	6646

7590 07/01/2003
Akin Gump Strauss Hauer & Feld
1900 Frost Bank Plaza
816 Congress Avenue
Austin, TX 78701

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

19

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,201

Applicant(s)

VOTICKY ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 98-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 98-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment filed on May 12, 2003. **Claims 98-118** are now pending in the present application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 12, 2003 has been entered.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 98,99,106-108,113 and 114 are rejected under 35 U.S.C. 102(b) as being anticipated by Scannell US Patent 5,377,354.

As per claim 98:

Scannell teaches of a method for an electronic communications message system (fig. 1) to prioritize an information message (abstract; col. 2, lines 36-37, 49-62) comprising:

determining a personalized identifier (sender field identifier) corresponding to the message, (col. 5, lines 32-39); wherein the personalized identifier does not require coordination between a user of the method and an originator of the message, (col. 7, lines 38-49);

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locating the personalized identifier in a database, (col. 7, lines 38-42; the comparator 52 locates the sender identifier in the sender-list field database that matches the received sender message);

assigning from the database a priority code (1 – highest priority through 5 – lower priority) corresponding the personalized identifier, (col. 6, lines 65-68); and

depositing the message into at least two of a plurality of virtual mailboxes (in-tray 16, FLDR-1 17, FLDR-2 18) wherein the message is prioritized within such virtual mailboxes based on the priority code, (col. 2, lines 21-27; col. 8, lines 14-18).

As per claims 99,108 and 114:

Scannell teaches of wherein the database, the personalized identifier, the priority code, and the correlation between the personalized identifier and the priority code are initially defined by a user and subsequently changeable by said user, (col. 6, lines 9-17; the user can set up rules that are used to prioritize the messages).

As per claims 106 and 107:

Scannell teaches a system for prioritizing a received information (abstract) message, comprising:

a database, (rules store 12);

a plurality of known personalized identifiers stored in the database, (col. 6, lines 18-22,27-30; fig. 2; the personalized identifiers represent the identity of the senders);

a plurality of priority codes, wherein each of the known personalized identifiers is associated with one of the plurality of priority codes, (col. 6, lines 65-68; the user assigns a priority level based on the sender/personalized identifier);

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a computing device (rules test unit) for determining a first personalized identifier associated with a received information message, (col. 5, line 65-col. 6, line 3) wherein the first personalized identifier is not dependent upon coordination between a user of the system and an originator of the received information message;

a priority assignment device for assigning a priority code to the received information message corresponding to a priority code associated with any matched first personalized identifier, (col. 9, lines 23-30); and

a prioritizer to prioritize the message according to the priority code, (col. 2, lines 21-27; ; col. 6, lines 65-68; col. 8, lines 9-19; col. 9, lines 23-30); and

a plurality of virtual mailboxes wherein the message is prioritized within such virtual mailboxes based on the priority code in at least two of the priority of mailboxes, (col. 8, lines 9-18)

As per claim 113:

Scannell teaches a computer-readable medium of instructions and data, comprising:

a received message, (abstract; col. 3, lines 37-39);

a personalized identifier corresponding to the received message (block 26 (sender) of message 25; fig. 2), wherein the personalized identifier does not require coordination between a user of the medium and an originator of the received message, (col. 7, lines 38-49);

computer instructions for receiving the message and the personalized identifier, (col. 3, lines 39-49);

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a database (Rules store 12; figs. 1 and 2) containing known personalized identifiers, each personalized identifier associated with a priority code of a plurality of priority codes, (col. 6, lines 18-22);

computer instructions for correlating the received personalized identifier with a known personalized identifier, (col. 7, lines 38-45); and

computer instructions for prioritizing the message according to the priority code associated with the correlated known personalized identifier, (col. 6, lines 65-68; abstract).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 100, 109 and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Larson et al. US Patent 6,408,068, (hereinafter Larson).

As per claims 100, 109 and 115:

Scannell, as applied to above, does not specifically teach wherein the prioritization includes an element of a response device for providing a personalized response to the originator.

Larson teaches of a system which sends personalized responses to the caller depending on their caller identification, (col. 13, lines 39-55). Larson teaches that a user will use custom messages so that specific types of callers such as callers with blocked caller ID or specific people such as relatives can receive a customized message. Blocked caller ID users will receive a general custom message whereas relatives can receive a more personalized message.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by having the system provide a

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personalized response to the sender based on the sender identification as taught by Larson so that the sender, if they are important to the message receiver, can receive a personalized message or if the identification can determine that the sender is not important then the system can play a general message.

7. Claims 101,104,110 and 116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Rochkind EP 0825752 A2.

As per claims 101,110 and 116:

While Scannell teaches of the information message being an e-mail message, Scannell does not specifically teach of the information message being a voice mail message.

Rochkind teaches that it was well known in the art to have a system which prioritizes and sorts e-mail messages, voice mail messages and multimedia messages, (page 2, lines 57-page 3, line 10; abstract). The system prioritizes incoming voice mail messages based on personalized rules set by the user such as using an address extension. The sender of a message will indicate an extension which will be used by the receiver's system to determine what priority the message should receive, (page 5, table 2). The message is then stored in the mailbox according to the priority code.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by prioritizing voice mail messages as taught by Rochkind so that a user can prioritize all of their incoming voice, email and multimedia messages.

As per claim 104:

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While Scannell teaches wherein the elements of the method are performed by a computer-automated system, Scannell does not specifically teach of wherein the elements are performed by an automated system selected from the group consisting of: a computer, a voice-type message storage device or a facsimile machine.

Rochkind teaches that it was well known in the art to have the method being performed by an automated system selected from the group consisting of: a computer, a voice-type message storage device, a facsimile machine, a combination of any two of the foregoing, and a combination of the first three of the foregoing, (page 2, lines 57-page 3, line 10; abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Scannell by using a voice-type message storage device or a facsimile machine as taught by Rochkind so that a user can prioritize all of their incoming voice, email and multimedia messages and can determine what messages are important without having to read or listen to all of the messages..

8. Claims 102,111 and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Rochkind and further in view of Epstein et al. US Patent 6,327,343.

As per claims 102,111 and 117:

While Scannell and Rochkind teach wherein the personalized identifier is derived from the identification of the sender, Scannell and Rochkind do not specifically teach of wherein the personalized identifier is derived from a voiceprint of an audio element associated with the voice mail message or is a biometric signature associated with the originator and the information message.

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Epstein teaches that it was well known in the art to use voiceprint/voice recognition to derive a personalized identifier from the received message and to prioritize the message based upon the derived information, (col. 5, lines 8-27,52-65;col. 9, lines 57-67). Epstein also teaches of associating a biometric signature (voiceprint) with the originator, (col. 5, lines 8-27; fig. 3B-step 210; col. 9, lines 12-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by employing the use of biometrics which include at least using voiceprints for identifying the sender of the incoming message as taught by Epstein so that the sender can still be identified if the caller ID was not received by the system.

9. Claim 103 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Rochkind and further in view of Larson.

As per claim 103:

Scannell and Rochkind, as applied to above, do not specifically teach wherein the prioritization includes an element of providing a personalized response to the originator based on the personalized identifier and the priority code.

Larson teaches of a system which sends personalized responses to the caller depending on their caller identification, (col. 13, lines 39-55). Larson teaches that a user will use custom messages so that specific types of callers such as callers with blocked caller ID or specific people such as relatives can receive a customized message. Blocked caller ID users will receive a general custom message whereas relatives can receive a more personalized message.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by having the system provide a

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personalized response to the sender based on the sender identification as taught by Larson so that the sender, if they are important to the message receiver, can receive a personalized message or if the identification can determine that the sender is not important then the system can play a different message.

10. Claims 105,112 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Epstein et al. US Patent 6,327,343.

As per claims 105,112 and 118:

While Scannell teaches wherein the personalized identifier is derived from the identification of the sender, Scannell does not specifically teach of wherein the personalized identifier is derived from a voiceprint of an audio element associated with the voice mail message or is a biometric signature associated with the originator and the information message.

Epstein teaches that it was well known in the art to use voiceprint/voice recognition to derive a personalized identifier from the received message and to prioritize the message based upon the derived information, (col. 5, lines 8-27,52-65;col. 9, lines 57-67). Epstein also teaches of associated a biometric signature with the originator, (col. 5, lines 8-27; fig. 3B-step 210; col. 9, lines 12-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Scannell by employing the use of biometrics which include at least using voiceprints for identifying the sender of the incoming message as taught by Epstein so that the sender can still be identified if the caller ID was not received by the system.

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Response to Arguments

11. Applicant's arguments with respect to claims 98-118 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262. The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group is (703) 872-9314.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante
Examiner
Group 2645
June 25, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written over the printed name and title.